

REMARKS

Review and reconsideration on the merits are requested.

Applicants first address the rejection of claims 1-51 under 35 U.S.C. § 102(e) as being anticipated by 2005/0272669.

The basis for this rejection is improper.

An International Application which was filed on or after November 29, 2000, such as the '669 application only becomes 35 U.S.C. § 102(e) prior art if it is published in English. The Examiner's attention is directed to MPEP page 1800-26, right column, item (B). See also the Example at MPEP 700-34, where the IA Publication by WIPO was not in English. The 35 U.S.C. § 102(e)(1) date for the IA Publication by WIPO is none, and the same result follows in the U.S. Simply stated, Fushimi is not available as prior art under 35 U.S.C. § 102(e)(1).

Since Fushimi was published in Japanese as an IA, the first date that Fushimi would become available as prior art would be March 4, 2004, the date of the IA Publication in Japanese. The present application's PCT date is December 4, 2003, prior to the 35 U.S.C. § 102(a) date for Fushimi.

Withdrawal is requested.

Applicants now address the rejection of claims 1-51 under 35 U.S.C. § 102(a) as being anticipated by Hossain et al referred to hereafter as Hossain, fully identified at the top of page 3 of the Action.

This rejection is respectfully traversed.

In the Action (page 3, second full paragraph), the Examiner states in speaking of the Hossain compounds which inhibit SGLT1 as follows:

“Since these compounds are shown to have non-competitive inhibition of SGLT1, it would be believed that they inherently comprised the non-inhibiting GLUT characteristics.”

First, non-competitive or competitive inhibition has no relationship to selectivity of inhibition.

Thus, even if the Hossain compounds have non-competitive inhibition, this does not mean that the Hossain compounds have selectivity of inhibition.

The Examiner also states as follows in the paragraph bridging pages 3/4 of the Action:

“[T]he Examiner notes that since selective inhibitors of the instant application also have no inhibitory effect on GLUT2 and/or GLUT5, the Examiner also believes that Hossain’s compounds would also be expected to have the same properties.”

In rebuttal, Applicants submit herewith for the Examiner’s consideration the publication Interaction of Flavenoids and Intestinal Facilitated Glucose Transporters Planta Med 2007: 73: 348-354 by Chen et al. (Chen)..

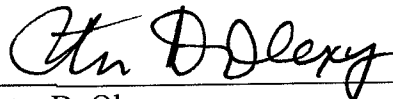
Chen shows that catechin and epicatechin gallate, which are disclosed as inhibiting SGLT1 in Hossain, inhibit GLUT2. See Chen at page 350, Table 1.

Even if Chen shows that epigallocatechin gallate, which is also disclosed in Hossain, does not inhibit GLUT2 (no data are provided regarding GLUT5), Applicants most strongly submit that Chen establishes that there is no reasonable relationship between SGLT1 inhibition and exhibiting the property of no inhibition of GLUT2 and/or GLUT5. Therefore, Applicants respectfully submit that the present claims are not anticipated by Hossain.

Withdrawal of the rejection is requested.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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